UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of
McCafferty, et al
Serial No.: 09/706,507
Filed: November 3, 2000
Attorney Docket No.: 13839-00012 (28111-32729E)

This is in response to applicants' "RESPONSE TO COMMUNICATION FROM COMMISSIONER AND PETITION UNDER 37 C.F.R. 1.181 AND 1.183" filed October 5, 2001, requesting reconsideration and withdrawal of the requirements for a Sequence Listing.

The petition was filed in response to a communication from the examiner mailed September 10, 2001, in which the examiner stated that the instant application failed to comply with the requirements of 37 C.F.R. 1.821-1.825. Specifically, applicant failed to provide a computer readable form (CRF) and a paper copy of the sequence listing along with a statement that the contents of the paper copy and CRF are the same and that no new matter has been added.

A review of the application history shows that instant application was filed as a continuation of U.S. patent application Serial No. 08/484,893, filed June 7, 1995, which was a continuation of U.S. patent application Serial No. 07/971,857, filed January 8, 1993, which was the U.S. national stage of PCT/GB91/01134, filed July 10, 1991. The exemption from filing a sequence listing is limited to the national stage filing under 37 C.F.R. 371. Therefore, the exemption only applied to 07/971,857 application which is the national stage of PCT/GB91/01134 which was filed before the implementation of equivalent PCT Administrative Instructions, Annex C. Accordingly, instant application is treated as new application and thus is required to comply with the sequence rules.

Applicant states that compliance with 37 C.F.R. 1.821-1.825 may be waived under "exceptional circumstances" and cites MPEP2421.01. Applicants submit that requiring the present application to comply with the sequence listing rules would place undue hardship on the applicants because the sequence data found in the present application is currently not available in CRF. Applicants

further state that it would require a huge expenditure of time and expense to manually enter and format numerous peptide and nucleotide sequences without providing commensurate benefit to either the USPTO or the public especially in view of the fact that none of the sequences are being claimed. Finally, applicants submit that amending the specification and the drawings to recite SEQ ID. NOs. would add to the examiner's burden in examining the instant application.

Applicants' arguments have been carefully considered and found unpersuasive for the following reasons:

1) With regard to the huge expenditure of time and expense to manually enter and formate numerous peptide and nucleotide sequences, applicants should note that the submission of the CRF increases accuracy of the search and reproduction, and reduces cost. Applicant can down load PatentIn 3.1 software program from USPTO website, for assistance please call General Information Service at (800) 786-9199 or (703) 308-4357 or e-mail to patin3help@uspto.gov. To reduce errored sequence listing, please use the CHECKER VERSION 3.0 Program which can be down loaded from the USPTO website at: http://www.uspto.gov/web/offices/pac/checker..

2) With regard to the burden of filing a second "substitute specification", applicant please note that compliance with the sequence rules does not necessarily result in the need of filing a substitute specification.

For sequences found in the specification, SEQ ID Nos need to be inserted for those sequences. For Figures, the SEQ ID Nos need to be inserted to both drawings and the corresponding Brief Description of Drawings of those sequences. In addition, a sequence listing needs to be added by amendment to the specification.

As to the claims, since no sequences are claimed, no amendment to the claims is required.

Applicant's statement of " ....excessively time consuming, prohibitively expensive..." is noted. The amendments may be complex and lengthy, it is not likely to be excessively expensive.

3) With regard to the statement of " ...without commensurate benefit to the PTO or the public..." , compliance with sequence rules reduces the difficulties in analysis and searching within the Office and outside the Office. Once the patent issued, the description must be sufficient to aid in the resolution of questions of infringement. As a general rule, the more standardized information that is provided for a particular sequence, the better the examiner or public will be able to compare the identity and characteristics of the sequence with prior art.

Accordingly, the petition is **DENIED**.

Applicant is required to comply with the requirements of 37 C.F.R. 1.821-1.825 as set forth in paper no. 14 mailed September 10, 2001.

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